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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,935	10/06/2003	Stephen Nelson Brooks	BRKS/0002	3604
21971	7590	01/27/2006	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050			WIEKER, AMANDA FLYNN	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/679,935	Applicant(s) BROOKS ET AL.	
	Examiner Amanda F. Wieker	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5-13, 15-25 and 30-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 14 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14; 4/05; 1/16.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species D in the reply filed on 06 January 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Applicant states that Claims 3, 5-13, 15-25, 30-31, 33, 35-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species.

However, claim 32 depends from withdrawn claim 31, and therefore is not considered to be an elected claim under Species D.

Claim 34 depends from elected claim 29, but refers back to elements ("the third magnet"; "the fourth magnet") introduced in withdrawn claim 31. Therefore, claim 34 is not considered to be an elected claim under Species D.

3. Applicant also states that claims 1, 2, 4, 14 and 29 are generic. The examiner disagrees. Species A does not disclose "magnets" as recited in claims 1, 2, 4, 14 and 29. Species A discloses a magnetically susceptible material, which is not necessarily a "magnet". Therefore, claims 1, 2, 4, 14 and 29 are not generic, to at least Species A.

4. Claims 3, 5-13, 15-25, 30-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06 January 2006.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting

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rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 29 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/982,172 ('172). Although the conflicting claims are not identical, they are not patentably distinct from each other because '172 discloses at least:

A method for treating sleep related breathing disorders (claim 1, line 1), comprising:

attaching a first magnet (claim 4, line 2) to a left lateral pharyngeal wall

("attaching a material to the lateral pharyngeal walls"; claim 1, line 5); and

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attaching a second magnet (claim 4, lines 2) to a right lateral pharyngeal wall ("attaching a material to the lateral pharyngeal walls"; claim 1, line 5) opposite the first magnet across an upper airway.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2, 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,176,618 to Freedman in view of U.S. Patent Application Publication Number 2003/0149488 to Metzger et al.

Freedman discloses a system for treating sleep-related breathing disorders, comprising:
a first magnet (14, Figures 5 or 7) attached to a first portion of a pharyngeal wall; and
a second magnet (10 or 10', Figures 5 or 7) attached to a second portion of an airway,
wherein the second magnet is positioned opposite the first magnet across an upper airway (see Figures 5 or 7). The magnets are implanted at their respective locations (col. 7, line 32). The magnets are permanent magnets (see description of magnetic orientation in absence of external magnetic field; at least cols. 7-8). Freedman does not specify that the magnets be attached to the left and right lateral pharyngeal walls.

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Metzger et al. discloses a system for treating sleep-related breathing disorders, comprising an implant (110) placed in the pharyngeal wall ([0049]). Metzger discloses that the left and right lateral pharyngeal walls are the portions of the airway most likely to lead to sleep-related breathing disorders ([0052, 0053, 0054, 0058]), and that the ideal device to treat these disorders is one that affects the left and right lateral pharyngeal walls ([0058]).

It would have been obvious to one skilled in the art at the time the invention was made to have provided the system for treating sleep-related breathing disorders as disclosed by Freedman, wherein the first and second magnets are implanted in the left and right lateral pharyngeal walls, as taught by Metzger et al., to effectively treat those portions of the airway most likely to cause sleep-related breathing disorders. The claimed method of treating sleep-related breathing disorders is made obvious by the normal use of the device taught by Freedman in view of Metzger et al.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman in view of Metzger et al., and in view of U.S. Patent Application Publication Number 2004/0045556 to Nelson et al.

Freedman in view of Metzger et al. disclose the previously described system for treating sleep-related breathing disorders, wherein first and second magnets are implanted in the left and right lateral pharyngeal walls. Freedman does not specify that the magnets be sutured in place.

Nelson et al. discloses a system for treating sleep-related breathing disorders using implanted magnets, wherein the magnets are retained in place by surgical sutures, to evenly distribute the forces from the magnets within the tissue in which the magnets are implanted.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the system for treating sleep-related breathing disorders as disclosed by Freedman in view of Metzger et al., wherein the first and second magnets are secured by surgical sutures, as taught by Nelson et al., to evenly distribute the forces from the magnets within the tissue in which the magnets are implanted.

Allowable Subject Matter

11. Claims 26-28 and 39-40 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

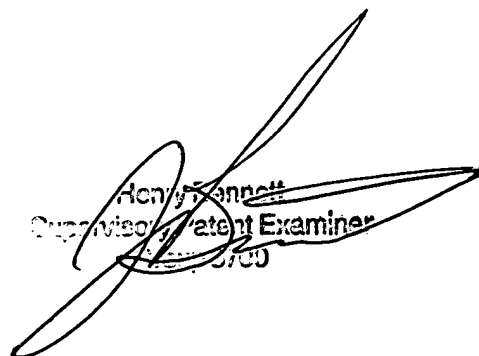
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Amanda F. Wieker

Examiner

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afw


Henry Fennett
Supervisory Patent Examiner
Art Unit 3743